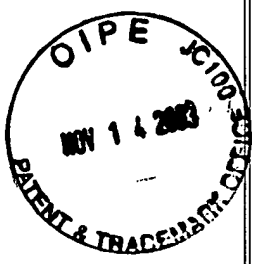


#17
Jm

PATENT
Customer No. 22,852
Attorney Docket No. 5725.0800



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Roland BAZIN et al.) Group Art Unit: 3743
)
Application No.: 09/725,048) Examiner: K. Ferko
)
Filed: November 29, 2000)
)
For: PROCESS FOR ACQUIRING)
SCANNED IMAGE DATA)
RELATING TO AN EXTERNAL)
BODY PORTION AND/OR A)
PRODUCT APPLIED THERETO)

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TECHNOLOGY CENTER R3700

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO OFFICE ACTION DATED JULY 15, 2003

The following remarks are responsive to the Office Action dated July 15, 2003.

Applicants are filing herewith a Petition for a one-month extension of time and fee payment to extend the response due date to November 15, 2003.

Claims 1-63 are pending.

In the Office Action, claims 1, 11, 30, 50, 51, and 60 were rejected under "35 U.S.C. 102 (a and/or e)" based on newly cited U.S. Patent No. 6,533,971 to Stess et al. ("Stess"). Stess discloses a method of forming a custom molded orthopedic impression shirt, wherein the method includes first mounting a release shirt or layer on a patient's torso and then mounting a resin-impregnated impression shirt over substantially the entire release shirt. (Col. 2, lines 20-31.) The resin of the impression

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shirt is allowed to harden and then the hardened impression shirt is removed from the torso. (Col. 2, lines 31-34.) Stess further discloses using a digital scanner 51 to scan the outside or inside of the hardened impression shirt so that an orthosis may be formed. (Col. 6, lines 3-27).

Applicants respectfully submit that the claim rejection based on Stess should be withdrawn because that reference does not disclose or suggest all of the subject matter recited in independent claim 1. For example, Stess's general disclosure of using a digital scanner 51 for obtaining digital data to enable creation of an orthosis (Col. 6, lines 3-27), does not disclose or teach "scanning . . . with an optical image scanner to obtain scanned image data for an image," as set forth in claim 1 (emphasis supplied). In particular, nothing in Stess discloses or suggests that the scanner 51 would obtain "image data" for an "image." Since the purpose of Stess's disclosed scanning of the impression shirt relates to proper dimensioning of an orthosis, one of ordinary skill in the art would understand that Stess's scanner 51 would merely obtain dimensions of the impression shirt rather than obtaining any "image data" for an "image."

In addition, assuming the Examiner is asserting that Stess's impression shirt somehow corresponds to a transfer member, there is no disclosure or teaching of "placing a transfer member in contact with an external portion of an individual," as recited in claims 1 and 63. As mentioned above, Stess discloses mounting the impression shirt over a release shirt rather than placing the impression shirt in contact with an individual's external portion.

For at least the above-mentioned reasons, Applicants respectfully request that the claim rejection based on Stess be withdrawn. In the event that the Examiner

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continues to reject the claims based on that reference, Applicants respectfully request the Examiner to provide Applicants with a better explanation of how the Examiner is rejecting the claims in view of Stess. For example, Applicants would appreciate an explanation of whether the Examiner is relying on an inherency assertion concerning the "scanning" recited in claim 1. Applicants would also appreciate an explanation of the subject matter in Stess that the Examiner is apparently equating with the transfer member of claim 1.

Claims 1, 12, 14-16, 21, 22, 25-27, 30-32, 50-54, and 63 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent 6,178,255 to Scott et al. ("Scott").

Applicants respectfully submit that the claim rejection based on Scott should be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine references. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim elements and limitations. See M.P.E.P. § 2143. Moreover, the requisite teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) and M.P.E.P. § 706.02(j). The mere fact that a reference is capable of being modified does not provide the sole basis for an obviousness rejection. M.P.E.P.

§ 2143.01

The Office Action fails to establish all of the prongs of the multi-part test noted above. Applicants believe that the Examiner has acknowledged that Scott lacks disclosure of a "transfer image [that] is not a fingerprint or fingerprints," as recited in claims 1 and 63. Despite that apparent acknowledgement, the Examiner has asserted that "it would be obvious to expand the system to include other body parts such as toe prints for the purpose of obtaining and database storing data of scanned image." (Office Action at 6.) The Office Action, however, lacks citation of any teaching or other source attempting to support that assertion. In particular, there is nothing providing any indication that one of ordinary skill in the art would have had any suggestion or motivation to use Scott's scanner to scan "other body parts." Such speculative reasoning and hindsight analysis clearly fails to set forth a *prima facie* case of obviousness.

In addition to the fact that the claim rejection should be withdrawn because there is no suggestion or motivation for the Examiner's proposed modification, Applicants submit that the claim rejection should also be withdrawn because Scott does not disclose or suggest "scanning [a] transfer image," as recited in claims 1 and 63. According to Applicants' understanding of the Examiner's remarks appearing in the Office Action at page 6, the Examiner has apparently asserted that one or more fingerprint impressions that might remain after touching Scott's platen 72 would somehow correspond to a transfer image. Even if a fingerprint impression might remain on Scott's platen 72 after it is touched, there is no disclosure of scanning that fingerprint impression. Rather than scanning a print impression left by a finger, Scott discloses directly scanning one or more fingers alone to acquire an optical image of the

actual fingers. (See col. 2, lines 8-10, and col. 4, line 39 through col. 5, line 6.)

Accordingly, there is no disclosure or suggestion of the claimed "scanning."

For at least these reasons, the claim rejection relying on Scott should be withdrawn. If the Examiner insists on maintaining the rejection of claims 1 and 63 without citing any reference in support of her assertion that certain subject matter would have been obvious, Applicants respectfully request the Examiner to submit a personal affidavit explaining the facts that the Examiner is relying upon to formulate the basis for the rejection, as required by 37 C.F.R. § 1.104(d).

Claims 1-3, 9-26, 30-40, 43-46, 49-59, and 63 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent 6,241,668 to Herzog ("Herzog").

Applicants respectfully submit that the claim rejection based on Herzog should be withdrawn because there is no *prima facie* case of obviousness. The Examiner has apparently acknowledged that Herzog's only disclosure relating to scanning concerns placing documents on a scanner, but the Examiner has alleged that "it is within the scope of the invention to use the scanner for obtaining human scanning information," that "it is well known to scan transfer images such as molds," and that "it would be obvious . . . to include scanning transfer members for the purpose of incorporating data in the system of Herzog." (Office Action at 6-7.) Applicants respectfully disagree with these allegations and note that the Office Action lacks a citation of any reference or other teaching to support the allegations set forth in the explanation of the claim rejection.¹ The Office Action's unsupported and conclusory allegations simply do not

¹ If the Examiner continues the claim rejection based on unsupported allegations, Applicants respectfully request that the Examiner supply an affidavit explaining the facts being relied upon to reject the claims.

provide a proper foundation for a *prima facie* case of obviousness. In addition, Herzog's mere disclosure of a "scanner 16" used to scan "additional documents, reports, graphics and/or films" (col. 3, lines 32-34) does not provide any teaching or suggestion of the claimed subject matter. Consequently, the claim rejection based on Herzog should be withdrawn.

Claims 1-10, 12, 14-16, 18, 27-30, 38-43, 46-50, and 60-63 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent 5,785,960 to Rigg et al. ("Rigg") in view of Stess.

Applicants respectfully submit that the Section 103(a) rejection based on Rigg in combination with Stess should be withdrawn because the Examiner has failed to establish any reasonable suggestion or motivation for one of ordinary skill in the art to have combined Rigg's subject matter relating to customizing skin foundation products with Stess's disclosure concerning formation of a custom molded orthopedic impression shirt used to make an orthosis. There is simply no legitimate reason why one of ordinary skill in the art would have used Stess's custom molded impression shirt along with Rigg's cosmetic foundation customizing system. The mere fact that references are capable of being combined is insufficient to support a *prima facie* case of obviousness. (see MPEP § 2143.01 (citations omitted).) Since the references relate to completely non-analogous arts, the Section 103(a) rejection should be withdrawn as being legally improper.

Claims 1-63 were provisionally rejected on the basis of obviousness-type double patenting in view of claims 1-67 of commonly owned U.S. Application No. 09/725,049.

Although Applicants do not necessarily agree with this rejection or the Examiner's

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assertions in the rejection statement, Applicants submit herewith a Terminal Disclaimer to obviate this provisional rejection.

For at least the reasons set forth above, all of the claim rejections should be withdrawn and all of the claims should be allowable.

The claim rejections contain numerous conclusory assertions about certain subject matter being disclosed or being obvious. Applicants do not understand the basis for many of the Examiner's assertions because the Office Action lacks any explanation of how the cited references allegedly disclose such subject matter and/or allegedly render it obvious. If the Examiner insists on maintaining any of the claim rejections, Applicants respectfully request that the Examiner set forth a detailed explanation of the basis for all of the assertions contained in the claim rejection statements.

Applicants respectfully request that the Examiner reconsider the application, withdraw the claim rejections, and issue a Notice of Allowability in a timely manner.

If a telephone conversation might advance prosecution of the present application, the Examiner is invited to contact the undersigned (571-203-2774).

Applicants note that the Office Action contains numerous assertions regarding the pending claims, Applicants' invention, the cited references, purported inventions of the cited references, and alleged "well-known" information, for example. Applicants respectfully disagree with a number of those assertions and decline to automatically subscribe to any of them, regardless of whether they are specifically identified above.

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Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 14, 2003

By: 
Anthony M. Gutowski
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